

REMARKS

Without acquiescing to the propriety of the rejections in the Office Action dated December 13, 2010, claims 1, 5, 9, 10, 13, 20, 28, 33, 34, 36 and 37 have been amended and claims 4, 23- 27, 30, 32, 35, 41 and 42 have been cancelled. Entry of these amendments, reconsideration of the present patent application and allowance of all claims pending herein are respectfully requested in view of the remarks below. Claims 38 and 71-82 were previously withdrawn, and claims 6, 7, 11, 12, 14-18, and 45-70 were previously cancelled. Claims 1-3, 5, 8-10, 13, 19, 20, 28, 29, 31, 33, 34, 36-40, 43, and 44 are now pending and under consideration.

Claim Objections:

The Office Action objected to claims 23-44 because amendments were alleged to have been made which were unmarked. Applicant respectfully points out that the claims in the Preliminary Amendment filed with the present application were amended relative to the Article 34 amendments made during the international phase. The Article 34 amendments were made under international rules (prior to the filing of the present application) and thus were not marked up (during the international phase) as is done in U.S. practice. Thus, this objection is believed to be overcome.

Further, the Office Action has objected to various claims due to a lack of sufficient antecedent basis. Claim 5 has been amended relative to this objection while claims 20, 26, 27, and 42 have been cancelled. Thus, these objections are believed to be overcome.

35 USC §102

Claims 1-5, 8 and 19 are rejected as being anticipated by Stone et al. (US 5,306,311) (hereinafter referred to as "Stone").

The Office Action has rejected claims 1-5, 8 and 19 alleging that Stone discloses the same invention being a cone shaped porous bioabsorbable plug implant comprising first and second circular planar portions having a tapered surface and a bioactive agent shown best in Figure 4B of Stone.

Amended claim 1 recites, *inter alia*, the first portion capable of being inserted into a defect of a bone and has a first surface, the second portion capable of engaging the contour of the defect and having a second surface opposite to the first surface, and the first surface having an area smaller than the area of the second surface. Support for these amendments are found at least at paragraphs [0071], [0075] and [0081].

Applicant submits that the implant of claim 1 is not disclosed in Stone. Although Stone discloses at column 5, lines 58 to 63 that the prosthetic articular cartilage device includes a matrix and a generally conical, rigid base component which extends downward from the underside of the matrix, there is no disclosure in Stone that the area of the surface of the base component is smaller than the area of the matrix. Accordingly, because all the features (e.g., an area of the surface of the base component smaller than the area of the matrix) of claim 1 of the present application are not identically disclosed by Stone, this claim cannot be anticipated thereby. The dependent claims are believed to not be anticipated for the same reasons and for their own additional features.

35 USC §103

Claims 9, 10, 13, 20, 23-37, 39-44 and 83 are rejected as being unpatentable over Stone in view of Masters (US 2002/0028243) (hereinafter referred to as “Masters”).

Since the plug implant as recited in claim 1 is made of expandable material, the plug implant may be used without requiring means for attachment like screws. In particular, the expandable material allows the implant to “snap fit” into the defect or gap in the bone. As explained at paragraph [0080] of the publication of the present application (US 2007/0083268), the absence of any means for attachment allows an easy placement of the implant in the shortest possible time.

Further, the structure of the implant also ensures that the implant is not pushed too far below the thickness of the bone (see paragraph [0081]). In particular, the larger surface area of the second portion ensures that the plug implant remains in the contoured position of the defect or gap of the bone.

As explained above Stone does not disclose the structure of the plug implant as recited in claim 1. In fact, Stone teaches a prosthetic articular cartilage in which the ridges of the base component allow

fixation and impaction into the bone, permitting the softer matrix to remain flush with the surface of the surrounding area of the bone into which the prosthetic articular cartilage is implanted. There is no teaching or suggestion in Stone of the second portion extending like a “top cap” in the defect or gap.

Masters does not rectify the deficiencies of Stone as there is no teaching in Masters of the structure of a plug implant as recited in claim 1. Masters is more concerned with the teaching of materials suitable for various medical devices but is silent on the mechanical structure of these devices. Accordingly, even if the teachings of Stone and Masters are combined, a skilled person would be unable to arrive at a plug implant having the advantages provided by the plug implant of claim 1.

Accordingly, the Applicant submits that the plug implant as recited in claim 1, and its dependent claims, are believed to be allowable over Stone in view of Masters.

Clarifying amendments have been made to claims 5, 9, 10, 13, 20, 28, 33, 34, 36 and 37. The dependencies of some of the claims have also been amended.

CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Examiner is invited to telephone the undersigned attorney at the telephone number provided.

Respectfully submitted,



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